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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte STEVEN L. PRATT and DENNIS WAYNE RIDDLEMOSER

Appeal 2008-0371
Application 09/726,266
Technology Center 2400

Decided:¹ March 31, 2009

Before ALLEN R. MACDONALD, JOHN A. JEFFERY, and
ST. JOHN COURTENAY III, *Administrative Patent Judges*.

MACDONALD, *Administrative Patent Judge*.

DECISION ON APPEAL

¹ The two-month time period for filing an appeal or commencing a civil action, as recited in 37 CFR § 1.304, begins to run from the decided date shown on this page of the decision. The time period does not run from the Mail Date (paper delivery) or Notification Data (electronic delivery).

STATEMENT OF CASE

Introduction

Appellants appeal under 35 U.S.C. § 134 from a final rejection of claims 1-3, 5-12, 15, and 18-28. We have jurisdiction under 35 U.S.C. § 6(b). Claims 4, 13, 14, 16, and 17 have been cancelled.

According to Appellants, the invention relates to the allocation of resources in a computer network. More specifically, the present invention relates to allocating resources based on user identification. (Spec. 1:10-13).

Exemplary Claim(s)

Exemplary independent claims 1 and 18 under appeal read as follows:

1. A method for managing resources in a computer network, comprising:

creating a particular configuration file for each user of a network, wherein each configuration file contains a list of the network resources that a user may access;

receiving a user identification at a client;

initiating a resource attachment program in response to receiving the user identification;

matching, using the resource attachment program, the user identification with a configuration file associated with the user identification; and

attaching, using the resource attachment program, network resources to the client based on the list contained in the configuration file associated with the user identification.

18. A computer program product in a computer readable medium for use in a data processing system for managing resources in a computer network, the computer program product comprising:

instructions for creating a particular configuration file for each user of a network, wherein each configuration file contains a list of the network resources that a user may access;

instructions for receiving a user identification at a client;

instructions for initiating a resource attachment program in response to receiving the user identification;

instructions for matching, using the resource attachment program, the user identification with a configuration file associated with the user identification; and

and instructions for attaching, using the resource attachment program, network resources to the client based on the list contained in the configuration file associated with the user identification.

Prior Art

The prior art relied upon by the Examiner in rejecting the claims on appeal is:

Corn	US 5,781,738	Jul. 14, 1998
Birrell	US 5,805,803	Sep. 8, 1998
Win	US 6,161,139	Dec. 12, 2000
Marks	US 2002/0010768 A1	Jan. 24, 2002

Rejections

1. The Examiner rejected claim 18 under 35 U.S.C. § 101 as being directed to non-statutory subject matter.

2. The Examiner rejected claims 1, 3, 5, 18, 19, and 27 under 35 U.S.C. § 102(e) as being anticipated by Marks.

3. The Examiner rejected claims 2, 6, 8, 9, 15, 20, 22, and 23 under 35 U.S.C. § 103(a) as being unpatentable over the combination of Marks and Win.

4. The Examiner rejected claims 7, 10, 11, 21, 24, 25, and 28 under 35 U.S.C. § 103(a) as being unpatentable over the combination of Marks and Corn.²

5. The Examiner rejected claims 12 and 26 under 35 U.S.C. § 103(a) as being unpatentable over the combination of Marks and Birrell.³

Appellants' Contentions

1. Appellants contend that the Examiner erred in rejecting claim 18 under 35 U.S.C. § 101 as being directed to non-statutory subject matter because:

- (A) “[T]he instant claim does not recite a signal.” (App. Br. 12).
- (B) There is no basis for holding a computer usable medium claim non-statutory because the medium may be intangible. (App. Br. 10).

² The rationale of Examiner's rejection discusses only Marks and Corn. However, the statutory statement mistakenly lists Win also. We treat this as a rejection based on only Marks and Corn as discussed by the Examiner.

³ The rationale of Examiner's rejection discusses Marks and Birrell. However, the statutory statement mistakenly lists Win instead of Marks. We treat this as a rejection based on Marks and Birrell as discussed by the Examiner.

2. Appellants contend that the Examiner erred in rejecting claims 1, 3, 5, 18, 19, and 27 under 35 U.S.C. § 102(e) as being anticipated by Marks because:

(A) Marks does not teach “creating a particular configuration file for each user of a network” as claimed in claim 1. (App. Br. 14).

(B) Marks does not teach “the claimed features of matching *and* attaching using the same resource attachment program, as recited in claim 1.” (App. Br. 14).

3. Appellants contend that the Examiner erred in rejecting claims 2, 6, 8, 9, 15, 20, 22, and 23 as being obvious over the combination of Marks and Win because:

(A) The failings of Marks alleged with respect to claim 1 are not corrected by Win. (App. Br. 18 and 23).

(B) The Examiner has not provided a proper teaching, suggestion, or motivation to combine Marks and Win. (App. Br. 19, 21, and 24).

4. Appellants contend that the Examiner erred in rejecting claims 7, 10, 11, 21, 24, 25, and 28 as being obvious over the combination of Marks and Corn because:

(A) The failings of Marks alleged with respect to claim 1 are not corrected by Corn. (App. Br. 26 and 29).

(B) The Examiner has not provided a proper teaching, suggestion, or motivation to combine Marks and Corn. (App. Br. 27-28 and 29).

5. Appellants contend that the Examiner erred in rejecting claims 12 and 26 as being obvious over the combination of Marks and Birrell because:

- (A) The failings of Marks alleged with respect to claim 1 are not corrected by Birrell. (App. Br. 31).
- (B) The Examiner has not provided a proper teaching, suggestion, or motivation to combine Marks and Birrell. (App. Br. 31-32).

Result

We affirm.

ISSUE(S)

Issues on Appeal

(1)

Whether Appellants have shown that the Examiner has erred in rejecting claim 18 because there is no requirement that claimed subject matter is tangible?

(2)

Whether Appellants have shown that the Examiner has erred in rejecting claims 1-3, 5-12, 15, and 18-28 because Marks does not teach limitations required by claims 1, 18, and 27?

(3)

Whether Appellants have shown that the Examiner has erred in rejecting claims 2, 6-12, 15, 20-26, and 28 because a teaching, suggestion, or motivation is required to combine references?

FINDINGS OF FACT

The following Findings of Fact (FF) are shown by a preponderance of the evidence.

Appellants' Invention

1. Appellants' invention provides a method for managing resources in a computer network based on user identity. (Spec. 3:4-5).
2. A configuration file defining specific resources is created for each network user. (Spec. 3:6-7).
3. Appellants' Figure 4 shows a flowchart illustrating a method for managing network resources on a per user basis is depicted in accordance with the present invention. (Spec. 9:22-25).
4. The process of Figure 4 begins by booting the machine (step 401). (Spec. 9:29-30).
5. Next, a resource attachment program is initiated when a user identification is entered during login (step 402). (Spec. 9:30-32).
6. The resource attachment program matches the user identity with a particular configuration file (step 403) and then reads the contents of the configuration file (step 404). (Spec. 10:1-4).
7. The configuration file contains a list of all the network resources that a user may access. These resources can include, for example, file systems, printers, disk drives, serial devices, peripheral devices, and any other shared hardware or software. The contents of the configuration file can be set and changed by a network administrator. (Spec. 10:4-10).

8. The resource attachment program uses the information in the configuration file to attach the authorized resources (step 405). (Spec. 10:13-15).

9. After the individual configuration of resources has been attached to the client, the attachment program creates a record containing a list of all successfully attached resources (step 406). (Spec. 10:15-18).

10. When the session on the client is finished, the user simply enters a routine logout command (step 407). The resources attachment program then detaches the resources listed in the attachment record created in step 406 (step 408). (Spec. 10:23-27).

11. After the resources are detached, the program deletes the contents of the attachment record (step 409), setting the client back to the original state before the user logged in at step 401. (Spec. 10:27-30).

Appellants' Admissions

12. Appellants admit:

[T]hose of ordinary skill in the art will appreciate that the processes of the present invention are capable of being distributed in the form of a computer readable medium of instructions and a variety of forms and that the present invention applies equally regardless of the particular type of signal bearing media actually used to carry out the distribution. *Examples of computer readable media include recordable-type media, such as a floppy disk, a hard disk drive, a RAM, CD-ROMs, DVD-ROMs, and transmission-type media, such as digital and analog communications links, wired or wireless communications links using transmission forms, such as, for example, radio frequency and light wave transmissions.*

(Spec. 11:16-29; emphases added).

Examiners Findings

13. The Examiner found that Marks describes creating a particular configuration file at paragraph 47 which states in-part:

In one embodiment, a middleware server in a network operations center queries the user database in the network operations center to determine a user profile for the user. The user profile includes the class of user and a set of user privileges and settings (e.g., application licenses, bookmarks, file access privileges, network access privileges, limited access to specific Web pages defined by specific URL allow and deny lists) for the user.

(Marks ¶ [0047]).

PRINCIPLES OF LAW

Burden on Appeal

Appellants have the burden on appeal to the Board to demonstrate error in the Examiner's position. *See In re Kahn*, 441 F.3d 977, 985-86 (Fed. Cir. 2006) ("On appeal to the Board, an applicant can overcome a rejection [under § 103] by showing insufficient evidence of prima facie obviousness or by rebutting the prima facie case with evidence of secondary indicia of nonobviousness.") (quoting *In re Rouffet*, 149 F.3d 1350, 1355 (Fed. Cir. 1998)). *See also Hyatt v. Dudas*, 492 F.3d 1365, 1369 (Fed. Cir. 2007) ("As we explained in *In re Oetiker*, the prima facie case is merely a procedural device that enables an appropriate shift of the burden of production.") *See Id.* ("Once the applicant is so notified, the burden shifts to the applicant to rebut the prima facie case with evidence and/or argument.")

For a rejection under § 102, Appellants may sustain this burden by showing that the prior art reference relied upon by the Examiner fails to disclose an element of the claim. It is axiomatic that anticipation of a claim under § 102 can be found only if the prior art reference discloses every element of the claim. *See In re King*, 801 F.2d 1324, 1326 (Fed. Cir. 1986) and *Lindemann Maschinenfabrik GMBH v. Am. Hoist & Derrick Co.*, 730 F.2d 1452, 1457 (Fed. Cir. 1984).

35 U.S.C. § 101

A transitory, propagating signal is not a “process, machine, manufacture, or composition of matter.” Those four categories define the explicit scope and reach of subject matter patentable under 35 U.S.C. § 101; thus, such a signal cannot be patentable subject matter. *In re Nuijten*, 500 F.3d 1346, 1357 (Fed. Cir. 2007) *reh’g en banc denied*, 515 F.3d 1361 (Fed. Cir. 2008), *cert. denied*, ___ U.S.___, 127 S.Ct. 70 (2008).

“If a claim covers material not found in any of the four statutory categories, that claim falls outside the plainly expressed scope of § 101 even if the subject matter is otherwise new and useful.” *Id.* at 1354.

Even when a claim covers patentable subject matter within the scope of 35 U.S.C. § 101, if the claim also covers subject matter that would be unpatentable under § 101, then applicant must limit the claim to avoid the nonstatutory subject matter to in turn avoid a rejection under § 101.

Cf. Amgen, Inc. v. Hoechst Marion Roussel, Inc., 314 F.3d 1313, 1329 (Fed. Cir. 2003) (“By limiting the claims in this way Amgen simply avoids claiming specific subject matter that would be unpatentable under § 101.”);

see also MPEP § 2105 (“If the broadest reasonable interpretation of the claimed invention as a whole encompasses a human being, then a rejection under 35 U.S.C. 101 must be made indicating that the claimed invention is directed to nonstatutory subject matter.”).

35 U.S.C. § 103

“Section 103 forbids issuance of a patent when ‘the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.’” *KSR Int'l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1734 (2007). The question of obviousness is resolved on the basis of underlying factual determinations including (1) the scope and content of the prior art, (2) any differences between the claimed subject matter and the prior art, (3) the level of skill in the art, and (4) where in evidence, so-called secondary considerations. *Graham v. John Deere Co.*, 383 U.S. 1, 17-18 (1966). *See also KSR*, 127 S. Ct. at 1734 (“While the sequence of these questions might be reordered in any particular case, the [*Graham*] factors continue to define the inquiry that controls.”)

In *KSR*, the Supreme Court emphasized “the need for caution in granting a patent based on the combination of elements found in the prior art,” *id.* at 1739, and discussed circumstances in which a patent might be determined to be obvious without an explicit application of the teaching, suggestion, motivation test.

In particular, the Supreme Court emphasized that “the principles laid down in *Graham* reaffirmed the ‘functional approach’ of *Hotchkiss*, 11 How. 248.” *KSR* at 1739 (citing *Graham v. John Deere Co.*, 383 U.S. 1, 12 (1966) (emphasis added)), and reaffirmed principles based on its precedent that “[t]he combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results.” *Id.* The Court explained:

When a work is available in one field of endeavor, design incentives and other market forces can prompt variations of it, either in the same field or a different one. If a person of ordinary skill can implement a predictable variation, §103 likely bars its patentability. For the same reason, if a technique has been used to improve one device, and a person of ordinary skill in the art would recognize that it would improve similar devices in the same way, using the technique is obvious unless its actual application is beyond his or her skill.

Id. at 1740. The operative question in this “functional approach” is thus “whether the improvement is more than the predictable use of prior art elements according to their established functions.” *Id.*

Under this framework, once an Examiner demonstrates that the elements are known in the prior art and that one of ordinary skill could combine the elements as claimed by known methods and would recognize that the capabilities or functions of the combination are predictable, then the Examiner has made a *prima facie* case that the claimed subject matter is

likely to be obvious. The burden then shifts to the Appellants to show that the Examiner erred in these findings or to provide other evidence to show that the claimed subject matter would have been nonobvious.

“[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” *KSR.*, 127 S. Ct. at 1741 (citing *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006)).

Claim Construction

"Our analysis begins with construing the claim limitations at issue."
Ex Parte Filatov, No. 2006-1160, 2007 WL 1317144, at *2 (BPAI 2007).

"The Patent and Trademark Office (PTO) must consider all claim limitations when determining patentability of an invention over the prior art." *In re Lowry*, 32 F.3d 1579, 1582 (Fed. Cir. 1994) (citing *In re Gulack*, 703 F.2d 1381, 1385 (Fed. Cir. 1983)). "Claims must be read in view of the specification, of which they are a part." *Markman v. Westview Instruments, Inc.*, 52 F.3d 967, 979 (Fed. Cir. 1995) (en banc). "[T]he PTO gives claims their 'broadest reasonable interpretation.'" *In re Bigio*, 381 F.3d 1320, 1324 (Fed. Cir. 2004) (quoting *In re Hyatt*, 211 F.3d 1367, 1372 (Fed. Cir. 2000)). "Moreover, limitations are not to be read into the claims from the specification." *In re Van Geuns*, 988 F.2d 1181, 1184 (Fed. Cir. 1993) (citing *In re Zletz*, 893 F.2d 319, 321 (Fed. Cir. 1989)).

ANALYSIS

35 U.S.C. § 101

Appellants contend that the Examiner erred in rejecting claim 18 under 35 U.S.C. § 101 as being directed to non-statutory subject matter because “the instant claim does not recite a signal” (App. Br. 12), and there is no basis for holding a computer usable medium claim non-statutory because the medium may be intangible (App. Br. 10). We disagree.

Appellants admit that “[e]xamples of computer readable media include . . . wireless communications links using transmission forms, such as, for example, radio frequency and light wave transmissions.” (FF 12). For this reason we conclude that, contrary to Appellants’ contention, claim 18 does recite a signal. Also contrary to Appellants’ contention and consistent with *Nuijten*, 500 F.3d 1346, we conclude that claim 18 must be limited to tangible embodiments. Since claim 18 is not so limited, Appellants have therefore not shown that the Examiner erred in rejecting claim 18 under 35 U.S.C. § 101 as being directed to non-statutory subject matter.

35 U.S.C. § 102

Appellants contend that the Examiner erred in rejecting claims 1, 3, 5, 18, 19, and 27 under 35 U.S.C. § 102(e) as being anticipated by Marks because Marks does not teach “creating a particular configuration file for each user of a network,” or “the claimed features of matching and attaching using the same resource attachment program,” each as recited in claim 1. (App. Br. 14). We disagree.

As to the limitation calling for “creating a particular configuration file for each user of a network,” Appellants’ Specification states that a configuration file defining specific resources is created for each network user. (FF 2). Neither Appellants’ Specification or claim language further limits this broad definition of a configuration file for each user. The Examiner found that paragraph 47 of Marks describes such a configuration file. As the Examiner further pointed out in the Answer at page 12, each user profile, which must be stored in the database in order to be retrieved, is a configuration file. We agree. We conclude that nothing in Appellants’ disclosure or claims precludes each configuration file from being a subcomponent of a larger database file such as in Marks.

As to Appellants’ argument regarding “the claimed features of matching and attaching using the same resource attachment program,” Appellants’ claim language merely requires “using the resource attachment program.” Such language places no restriction on the form or amount of this usage. That is, the claim language broadly requires some amount of usage of a single program to perform the two steps. We conclude that a program be used during the initiating of a step is sufficient to be usage. Appellants point out that middleware is used in the matching step to determine user and device privileges (App. Br. 16) and as the Examiner correctly pointed out in the Answer at pages 12-13, the network operations center software (i.e., program) includes this middleware and also provides the resulting privileges to the client application thus initiating the attaching. We conclude that Marks’ software system for matching and attaching is not precluded by the claim language.

Therefore, for the reasons above, Appellants have not established that the Examiner erred with respect to this rejection of claims 1, 3, 5, 18, 19, and 27 under § 102.

35 U.S.C. § 103

Appellants contend that the Examiner erred in rejecting claims 2, 6-12, 15, 20-26, and 28 under 35 U.S.C. § 103(a) as being unpatentable because as argued with regards to claim 1, Marks does not teach “creating a particular configuration file for each user of a network,” or “the claimed features of matching and attaching using the same resource attachment program,” (App. Br. 18, 23, 26, 29, and 31). We disagree for the reasons discussed *supra* with regards to claim 1.

Appellants also contend that the Examiner erred in rejecting claims under 35 U.S.C. § 103(a) as being unpatentable because the Examiner has not provided a proper teaching, suggestion, or motivation to combine Marks with any of Win, Corn, or Birrell (App. Br. 19, 21, 24, 27-29, 31, and 32). We disagree.

Appellants’ contentions and arguments that the Examiner is required to provide a teaching, suggestion, or motivation to combine the various references are without merit. Rather, all the references before us are in the same field of computer network access, and the Examiner has demonstrated that the claimed elements were known in the prior art and that one of ordinary skill could have combined the elements as claimed by known methods and would have recognized that the capabilities or functions of the combination were predictable. *See KSR*, 127 S. Ct. 1727.

We conclude that based on the strength of Examiner prima facie showing, nothing in Appellants arguments is sufficient to rebut a final conclusion of obviousness with regard to these claims.

Therefore, for the reasons above, Appellants have not established that the Examiner erred with respect to this rejection of claims 2, 6-12, 15, 20-26, and 28 under § 103.

CONCLUSION OF LAW

(1) Appellants have failed to establish that the Examiner erred in rejecting claim 18 as being unpatentable under 35 U.S.C. § 101 because there is a requirement that claimed subject matter is tangible.

(2) Appellants have failed to establish that the Examiner erred in rejecting claims 1, 3, 5, 18, 19, and 27 as being anticipated under 35 U.S.C. § 102(e) because Marks does teach the limitations required by claims 1, 18, and 27.

(3) Appellants have failed to establish that the Examiner erred in rejecting claims 2, 6-12, 15, 20-26, and 28 as being unpatentable under 35 U.S.C. § 103(a) because Marks does teach the limitations required by claims 1, 18, and 27.

(4) Appellants have failed to establish that the Examiner erred in rejecting claims 2, 6-12, 15, 20-26, and 28 as being unpatentable under 35 U.S.C. § 103(a) because a teaching, suggestion, or motivation is not necessarily required to combine references.

(5) Claims 1-3, 5-12, 15, and 18-28 are not patentable.

Appeal 2008-0371
Application 09/726,266

DECISION

The Examiner's rejections of claims 1-3, 5-12, 15, and 18-28 are affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED

pgc

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